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08/251,508	11/17/97	HARUKI	826-18317-10H

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LM71/0806

MYHRE, J EXAMINER

ART UNIT PAPER NUMBER
2757

DATE MAILED: 08/06/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/971,903

Applicant(s)
Haruki et al

Examiner
James Myhre

Group Art Unit
2767



☒ Responsive to communication(s) filed on Jun 16, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Response to Amendment

1. The amendment filed on June 16, 1999 has been considered but is ineffective to overcome the Hill (5,761,649) and Peschel, Joe, Infoworld references.

Drawings

2. The corrected or substitute drawings were received on June 16, 1999. These drawings are acceptable; however, formal drawings will be required upon allowance of application.

Claim Objections

3. The amended claims 1 and 2 overcome the objections raised in paragraph 3 of paper number 3. The Examiner hereby withdraws these objections.

Claim Rejections - 35 USC § 101

4. The amended claims 1-14 are now deemed statutory in nature and overcome the 35 U.S.C. 101 rejection raised in paragraph 5 of paper number 3. The Examiner hereby withdraws this rejection.

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Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

6. Claims 1-4 and 10-13, and 16-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Hill (5,761,649).

Claims 1, 10-13, 16, 17: Hill discloses a system and method for registering and updating software on a remote computer, comprising:

a. User information general management means managing user registration information and status information by managing product information data and providing new or updated information in accordance with a request from a user (col 4, lines 22-40 and col 5, lines 57-67); and

b. User registration/reference means for notifying the general management means of the user registration and status information and for requesting new information about the product (col 4, lines 9-21 and col 5, lines 51-57).

Claim 2: Hill discloses a system and method for registering and updating software on a remote computer as in Claim 1 above, and further discloses means for the user to request new information about a product from the general management means (col 5, lines 4-30).

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Claim 3: Hill discloses a system and method for registering and updating software on a remote computer as in Claim 2 above, and further discloses the registration process being built into the software and automatically executed upon installation on the user's computer (col 4, lines 11-15; col 5, lines 30-36; and col 9, lines 46-48).

Claim 4: Hill discloses a system and method for registering and updating software on a remote computer as in Claim 2 above, and further discloses:

- a. A personal identification number as part of the registration information (col 4, lines 15-31); and
- b. The type of requested information which is extracted by the general management means and transmitted to the user (col 3, lines 9-31).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 7-9, 14, 15, and 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill (5,761,649) in view of Peschel, Joe, Infoworld.

Claims 7, 8, 14, 15, and 18-20: Hill discloses a system and method for registering and updating software on a remote computer as in Claim 2 above, but does not explicitly disclose

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multiple vendors updating the product information database of the general management means by providing new information pertaining to the type of product as requested by the user. Peschel discusses a software application called *Oil Change* from CyberMedia Inc. which automatically updates application and drivers on a user's computer by connecting to a centralized external database. Peschel further discusses allowing vendors (companies) to directly update the information about their products in the database (page 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to expand Hill's general management means' database by connecting to one or more external vendors and to allow them to update their product's information. One would have been motivated to do this in order to increase the number of software products that Hill's system could update and to ensure that the database contained the latest information available from each vendor as discussed by Peschel.

Claim 9: Hill discloses a system and method for registering and updating software on a remote computer as in Claim 2 above, and Peschel discusses *Oil Change* which allows vendors to update the centralized database. Peschel further discusses *Oil Change* using a database which contains the information about the latest versions of products, but which connects the user to the vendor's system to actually download the complete "fix" or update (using Yellow Pages)(Page 2). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include links to vendors in the database. One would have been motivated to include links to the vendors in order to decrease the size of the database, thus increasing the efficiency and speed by which the system could respond to an inquiry from a user.

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9. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hill (5,761,649).

Claims 5 and 6: Hill discloses a system and method for registering and updating software on a remote computer as in Claim 2 above, but does not explicitly disclose basing the automatic update of the software on the number of times the application had been accessed. Official notice is taken that it is old and well known within the technological art to conduct periodic checks of software and that these checks could be based on a time limit or a maximum number of uses. An example of using the usage number in the industry is the “demo” software programs available from vendors. A demo is normally able to be used for a limited number of times, after which it either erases itself, prevents the user from activating the program, or it merely notifies the user that the “free use” period has expired. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to periodically check the software applications being tracked by Hill’s invention and that these checks could be based on usage or time. One would have been motivated to track them by the number of times the software had been used in order to minimize the number of updates by ensuring the software with the highest usage level is always at the most up-to-date status possible and the software which is seldom used is only updated when it needs to be used.

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Response to Arguments

10. Applicant's arguments filed June 16, 1999 have been fully considered but they are not persuasive.

Referencing Applicant's argument that "Hill does not contain a general management unit or equivalent" but sends the transmittal "directly between the customer and the vendor", Examiner notes that the general management unit as claimed is not limited to either a vendor's computer or a third party computer but could be located on either, the same as the Hill's "main computer" is described as the vendor's computer in columns 17 and 18 but is also described in columns 4 and 5 with an ambiguous location not equated with a vendor's computer.

Referencing Applicant's argument that "the catalog product information as transmitted in Hill has nothing to do with a computer-related product in use", Examiner notes that Hill also discloses embodiments of his invention which track software product registration information and automatically update the software with the latest revision as noted in columns 4-5 and 17-18 cited above.

Referencing Applicant's argument about the applicability of the Peschel reference, Examiner notes that this reference was not cited for its method of searching for or updating the user's software as argued by the Applicant but was cited for its disclosure of multiple vendors updating the product information in the main computer's database (page 2).

Referencing Applicant's argument pertaining to the rejection of claims 5 and 6 that "an update request in Hill has to be affirmatively entered by the user", Examiner notes that Hill

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explicitly states that “a method is provided for automatically updating a program on a remote computer” (col 4, lines 23-24). The user does not have to request the update, the inventive system automatically checks the revision status of the user’s software and downloads the latest revision when appropriate.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached on weekdays from 6:00 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Allen R. MacDonald, can be reached on (703) 305-9708. The fax phone number for

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Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or informal faxes for this Art Unit can be submitted to (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-3900.



JWM

August 5, 1999



ALLEN R. MACDONALD
SUPERVISORY PATENT EXAMINER